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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,400	03/12/2004	Nobuaki Mihara	029650-147	6062

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BUCHANAN, INGERSOLL & ROONEY PC
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EXAMINER

BOUCHELLE, LAURA A

ART UNIT	PAPER NUMBER
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3763

NOTIFICATION DATE	DELIVERY MODE
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09/11/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com
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Office Action Summary

Application No.

10/798,400

Applicant(s)

MIHARA ET AL.

Examiner

Laura A. Bouchelle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/26/07 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 9, 10, 11-14, 20, 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al (US 2003/0153942).

4. Wang discloses an embolic protection catheter 10 comprising a solid metal linear wire 22 having a covering layer 16 comprises of a resin material (page 1, paragraph 0017), a tubular body 26 placed on the distal end of the linear wire and allowing a guidewire 24 to penetrate its hollow portion 32. See Fig. 1. The proximal portion 28 of the tubular member is decentered

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with respect to the center of the linear wire and therefore, the tubular member and the wire are not coaxial. A coupling member 18 fixes the linear wire to the tubular member.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 5, 15, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Estrada et al (US 2002/0038103).

7. Claims 4, 15 differ from Wang in calling for the tubular body to include a plurality of markers. Estrada teaches a catheter having a proximal portion 11 and a distal tubular member 34 having markers 39, 45 that allow for observation of the location of the distal portion during a procedure (page 3, paragraph 0037). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Wang to include distal markers as taught by Estrada to facilitate observation of the device during a procedure.

8. Claims 5, 16 differ from Wang in calling for the tubular member to be formed of an inner layer, an outer layer, and a reinforcing member therebetween. Estrada teaches a tubular member 34 for insertion of a guidewire 36 therethrough being formed of an inner layer 43, and outer layer 44, and a reinforcing member 42 therebetween to provide the flexibility required to insert the device through the vasculature and also the stiffness to prevent kinking (page 3, paragraph 0037).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Wang so that the tubular member is made of an inner layer, an outer layer, and a reinforcing member therebetween as taught by Estrada.

9. Claims 6-8, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Solar et al (US 6447501).

10. Claims 6, 17 differ from Wang in calling for an operation portion on the proximal end of the linear wire. Claims 7, 18 differ in calling for the operation portion to be adjusted and fixed for its position with respect to the wire. Solar teaches a stent delivery system comprising a wire 46 having a tubular member 18 attached to the distal end for insertion of a guidewire 9 therethrough, further comprising an operation member 30 that is adjustable and fixed for its position relative to the linear wire to allow for positioning of the device (Col. 4, lines 44-47). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Wang to include an operation portion as taught by Solar.

11. Claims 8, 19 differ from the teachings above in calling for the operation portion to be adhered to the linear wire. Solar is silent as to the method of attaching the operation portion to the linear wire. It would have been obvious to one of ordinary skill in the art at the time of invention to adhere the operation portion to the linear wire, as it is a well known technique in the art for securing two components to each other.

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Response to Arguments


12. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura A. Bouchelle whose telephone number is 571-272-2125. The examiner can normally be reached on Monday-Friday 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 517-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


NICHOLAS D. LUCCHESI
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Laura A Bouchelle
Examiner
Art Unit 3763

